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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,159	08/23/2001	Paul Clinton Coffin	10012828-1	1251

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EXAMINER	
TRAN, HANH VAN	

ART UNIT	PAPER NUMBER
3637	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,159	COFFIN ET AL.	
	Examiner	Art Unit	
	Hanh V. Tran	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21,22,24-29 and 35-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21,22,24-29,35-42 and 54-62* is/are rejected.

7)☒ Claim(s) *43-53* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is the Final Office Action from the examiner in charge of this application in response to applicant's amendment dated 11/12/2004.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 21-22, 24-29, 35-42, and 54-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,116,063 to Foslien in view of USP 6,480,391 to Monson et al.

Foslien discloses a data storage system comprising all the elements recited in the above listed claims including, such as shown in Figs 2-3, a data storage system housing 30 having an opening, a first elongate bottom reference rail located adjacent the opening, a plurality of media storage devices each having a housing 54 movable between a storage position within the data storage system and an extended position, the housing having a top, a bottom and opposing ends, a first elongate bottom alignment groove adapted to slidably engage with the first elongate bottom reference rail of the data storage system housing 30, a locking plate attached to the housing and configured to engage a locking mechanism located in the opening in the data storage

system, a handle operationally attached to the housing, a side portion of the housing having a plurality of slots (56,58) configured to receive the data media, a spring mechanism of a metallic strip configured to engage the data media when received within the slots, a plurality of dividers positioned in spaced-apart relation within the housing, wherein the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the elongate bottom reference rail and the elongate bottom alignment groove and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis 64, such as shown in Fig 2, transverse to the longitudinal axis. Foslien further discloses it is well known that a data storage system (column 5, lines 3-30) including a picker assembly/a media handling system for transferring data media 60,62 from the media storage device to a data exchange device. Foslien, however, does not clearly disclose the data storage system housing having a second elongate top alignment groove in a top portion of the data storage system housing and the media storage device housing having a second elongate top alignment groove in a top portion of the media storage device housing adapted to slidably engage with the corresponding second elongate top reference rail located adjacent an opening in the data storage system.

Monson et al discloses a media storage device comprising a first housing 95 having means for slidably inserting and removing the media storage device within the opening in the data storage system housing 50, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment

groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located in a top portion of the data storage system housing 50 and a second elongate reference rail locate in a bottom portion of the data storage system housing 50 and adjacent an opening in the data storage system in order to facilitate inserting and removing the first housing from the data storage system. Therefore, it would have been obvious to modify the structure of Foslien by providing the housing with means for slidably inserting and removing the media storage device within the opening in the data storage system, wherein said slidably inserting and removing means including a first elongate alignment groove in a top portion of the housing and a second elongate alignment groove in a bottom portion of the housing adapted to slidably engage with a corresponding first elongate reference rail located in a top portion of the data storage system housing 50 and a second elongate reference rail locate in a bottom portion of the data storage system housing 50 and adjacent an opening in the data storage system in order to facilitate inserting and removing the housing from the data storage system, as taught by Monson et al, since both teach alternate conventional media storage device structure, used for the same intended purpose, thereby providing structure as claimed.

5. Claims 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foslien in view of USP 5,596,556 to Luffel et al and USP 6,160,786 to Coffin et al.

Foslien discloses a data storage system comprising all the elements recited in the above listed claims including a data storage system housing 30 having an opening and reference structures; a media storage device for storing a plurality of data media devices, the media storage device having a housing 54 with alignment structures to slidably engage the respective reference structures to enable slidable movement of the media storage device through the opening of the

data storage system housing. The differences being that Foslien does not clearly disclose a moveable media exchange device to receive the media storage device, the media exchange device moveable between a retracted position and an extended position, wherein the media storage device is positioned inside the data storage system housing when the media exchange device is in the retracted position, and wherein the media storage device protrudes from the data storage system housing when the media exchange device is in the extended position; and guide structures to moveably guide the media exchange device between the retracted and extended positions.

However, it is well known in the art that a data storage system as shown in Foslien would include a moveable media exchange device to receive the media storage device. Further, Luffel et al and Coffin et al teaches that it is well known in the art to provide a data storage system with a moveable media exchange device to receive the media storage device, the media exchange device moveable between a retracted position and an extended position, wherein the media storage device is positioned inside the data storage system housing when the media exchange device is in the retracted position, and wherein the media storage device protrudes from the data storage system housing when the media exchange device is in the extended position; and guide structures to moveably guide the media exchange device between the retracted and extended positions for the purpose of facilitate transporting of data media. Therefore, it would have been obvious to provide the data storage system of Foslien with a moveable media exchange device to receive the media storage device, the media exchange device moveable between a retracted position and an extended position, wherein the media storage device is positioned inside the data storage system housing when the media exchange device is in the retracted position, and wherein

the media storage device protrudes from the data storage system housing when the media exchange device is in the extended position; and guide structures to moveably guide the media exchange device between the retracted and extended positions for the purpose of facilitate transporting of data media, as taught by Luffel and Coffin, since the references teach alternate conventional data storage system, used for the same intended purpose, thereby providing structure as claimed.

Allowable Subject Matter

6. Claims 43-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 11/12/2004 have been fully considered but they are not persuasive.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated in the above art rejection, Foslien is being modified in view of Monson in order to facilitate inserting and removing the housing from the data storage system, since both references are drawn alternate conventional media storage device.

9. In response to applicant's arguments on page 11 that Monson teaches an individual storage device, not a media storage device, the examiner takes the position that the claimed language fails to provide adequate structural limitations in order to distinguish applicant's invention from Foslien in view of Monson.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inoue shows structures similar to various elements of applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (703) 308-6302. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVT HVT
February 21, 2005

LANNA MAI
SUPERVISORY PATENT EXAMINER
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Lanna Mai